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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Platon N. Mandros
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

REFAI, RAMSEY

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/961,363

Applicant(s)

IDEHARA ET AL.

Examiner

Ramsey Refai

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

In view of the Appeal Brief filed on January 18, 2006, PROSECUTION IS HEREBY REOPENED. New grounds of Rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 46-47, 49-52, 55-59, 62, and 64-65 rejected under 35 U.S.C. 102(e) as being anticipated by Wallis et al (U.S. Patent No. 6,282,569).

3. As per claim 46, Wallis et al teach a data transmission device to be used in a system including said data transmission device and a data receiving device which are connected to a network, and at least one portable terminal (Figure 1), said data transmission device comprising:

a first transmission unit transmitting to said portable terminal a signal for obtaining device information from said data receiving device, the device information containing connection information for establishing a connection between said data transmission device and said data receiving device (Figure 1, column 2, lines 49-67, column 3, line 45-column 4, line 6);

a receiving unit receiving the device information from said portable terminal (**Figure 1, column 2, lines 49-67, column 3, line 45-column 4, line 6**); and

a second transmission unit transmitting to said data receiving device a signal for requesting a connection based on the device information (**Figure 1, column 2, lines 49-67, column 3, line 45-column 4, line 6**).

4. As per claim 47, Wallis et al teach the second transmission unit transmits data to said data receiving device via said network after establishing a connection with said data receiving device (**column 2, lines 55-60**).

5. As per claim 49, Wallis et al teach said connection information contains an identification code for identifying said data receiving device on said network (**column 5, lines 15-21**).

6. As per claim 50, Wallis et al teach said identification code is an IP address (**column 5, lines 15-21**).

7. As per claim 51, Wallis et al teach a data receiving device to be used in a system including a data transmission device and said data receiving device which are connected to a network, and at least one portable terminal (**Figure 1**), said data receiving device comprising:

a transmission unit transmitting device information to said portable terminal according to a request signal from said portable terminal, the device information containing connection information for establishing a connection between said data transmission device and said data receiving device (**Figure 1, column 2, lines 49-67, column 3, line 45-column 4, line 6**); and

a connection unit establishing a connection with said data transmission device according to a signal for requesting the connection transmitted from said data transmission device based on the device information (**Figure 1, column 2, lines 49-67, column 3, line 45-column 4, line 6**).

8. As per claim 52, Wallis et al teach said transmission unit comprises a communication unit communicating in short distances for transmitting the device information to said portable terminal (**column 1, lines 13-20; LAN**).

9. As per claim 55, Wallis et al teach which said communication unit comprises a wired communication unit (**column 1, lines 13-21**).

10. As per claim 56, Wallis et al teach said connection information contains an identification code for identifying said data receiving device on said network (**column 5, line 16-21**).

11. As per claim 57, Wallis et al teach said identification code is an IP address (**column 5, line 16-21**).

12. As per claim 58, Wallis et al teach a portable terminal to be used in a system including a data transmission device and a data receiving device which are connected to a network, and said portable terminal (**Figure 1**) said portable terminal comprising:

a first transmission unit transmitting to said data receiving device a signal for requesting transmission of device information according to a request from said data transmission device, the device information containing connection information for establishing a connection between said data transmission device and said data receiving device (**Figure 1, column 2, lines 49-67, column 3, line 45-column 4, line 6**);

a receiving unit receiving the device information from said data receiving device; and a second transmission unit transmitting the device information received from said data receiving device to said data transmission device (**Figure 1, column 2, lines 49-67, column 3, line 45-column 4, line 6**).

13. As per claim 59, Wallis et al teach said first transmission unit and said receiving unit comprise a communication unit communicating in short distances for transmitting and receiving data with said data receiving device (**column 1, lines 13-20; LAN**).

14. As per claim 62, Wallis et al teach said communication unit comprises a wired communication unit (**column 1, lines 13-21**).

15. As per claim 64, Wallis et al teach said connection information contains an identification code for identifying said data receiving device on said network (**column 5, line 16-21**).

16. As per claim 65, Wallis et al teach said identification code is an IP address (**column 5, line 16-21**).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 48, 53, 60, 63, 66 -68, 70, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallis et al in view of Bender et al (U.S. Patent No. 6,535,918).

19. As per claim 48, Wallis et al fail to teach a mobile telecommunication network. However, Bender et al teach the use of mobile systems such as TDMA, CDMA, and GSM to provide the user with wireless data service (column 2, line 1-10, abstract). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Wallis et al and Bender et al because doing so would allow a user of a wireless data service to obtain the address of a destination server in order to obtain data wirelessly.

20. As per claim 53, Wallis et al fail to teach said communication comprises a wireless communication unit. However, Bender et al teach the use of mobile units such as hand held communication systems, portable data units, etc, used in mobile systems such as TDMA, CDMA, and GSM to provide the user with wireless data service (column 1, line 49- column 2, line 10, abstract). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Wallis et al and Bender et al because doing so would allow a user of a wireless data service to obtain the address of a destination server in order to obtain data wirelessly.

21. As per claim 60, Wallis et al fail to teach said communication unit comprises a wireless communication unit. However, Bender et al teach the use of mobile units such as hand held communication systems, portable data units, etc, used in mobile systems such as TDMA, CDMA, and GSM to provide the user with wireless data service (column 1, line 49- column 2, line 10, abstract). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Wallis et al and Bender et al because doing so would allow a user of a wireless data service to obtain the address of a destination server in order to obtain data wirelessly.

22. As per claim 63, Wallis et al fail to teach a mobile telecommunication network. However, Bender et al teach the use of mobile systems such as TDMA, CDMA, and GSM to provide the user with wireless data service (column 2, line 1-10, abstract). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Wallis et al and Bender et al because doing so would allow a user of a wireless data service to obtain the address of a destination server in order to obtain data wirelessly.

23. As per claim 66, Wallis et al teach a data receiving device to be used in a system including a data transmission device and said data receiving device which are connected to a network, and a portable terminal, said data receiving device comprising:

a communication unit receiving device information of said data transmission device from said portable terminal, the device information containing connection information for establishing a connection between said data transmission device and said data receiving device (Figure 1, column 2, lines 49-67, column 3, line 45-column 4, line 6); and

a controller deleting the device information if a certain condition is satisfied (column 9, lines 4-29)

24. Wallis et al fail to teach that the communication is wireless. However, Bender et al teach the use of mobile systems such as TDMA, CDMA, and GSM to provide the user with wireless data service (column 2, line 1-10, abstract). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Wallis et al and Bender et al because doing so would allow a user of a wireless data service to obtain the address of a destination server in order to obtain data wirelessly.

25. As per claims 67 and 68, Wallis et al-Bender teach wireless telecommunication devices that operate in wireless systems such as CDMA, TDMA, GSM, etc but fail to teach the certain condition includes a condition where the communication unit fails to communicate with the portable terminal device and wherein the certain condition includes a condition when the portable terminal device is out of a range from the communication unit. However, one skilled in the art would know that these claimed features are inherent in such telecommunication systems such as CDMA, TDMA, and GSM. When a user roams outside of their network, connections are lost until a new connection in or outside the user's service network is established. It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to include this feature in the Wallis et al-Bender system because doing so would allow for an existing communication to terminate once the user is beyond service range.

26. As per claim 70, Wallis et al teach said connection information contains an identification code for identifying said data receiving device on said network (column 5, line 16-21).

27. As per claim 71, Wallis et al teach said identification code is an IP address (column 5, line 16-21).

28. Claims 54, 61, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallis et al in view of Bender in further view of Liberti et al (U.S. Patent No. 6,947,408).

29. As per claims 54, 61, and 69, Wallis et al-Bender fail to teach said communication unit carries out communication based on either Bluetooth®, IEEE 802.11, HomeRF®, or IrDA ®. However, Liberti et al teach

wireless data systems that are IEEE 802.11 compliant (column 1, line 15-45). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Wallis et al, Bender and Liberti et al because doing so would provide portability by allowing users to obtain addresses for other devices in a network in order to establish a connection and communicate data to those devices using the obtained address to obtain data wirelessly.

Response to Arguments

30. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey Refai
Examiner
Art Unit 2152 


BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER